

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 1

Filed by: Fred E. McKelvey
Senior Administrative Patent Judge
Box Interference
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Filed
10 January 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

JAN 10 2002

ALFRED POLLAK and ANNE GOODBODY,

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Junior Party,
(Patent 5,662,885 and Patent 5,780,006),

v.

WILLIAM McBRIDE and RICHARD T. DEAN,

Senior Party
(Application 08/253,973).

Patent Interference 104,789 (McK)

NOTICE DECLARING INTERFERENCE
(37 CFR § 1.611)

Part A. Declaration of interference

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties.

Details of the applications, patents, counts and claims designated as corresponding or as not corresponding to the counts appear in Parts E and F of this NOTICE DECLARING INTERFERENCE.

Part B. Judge designated to handle the interference

Senior Administrative Patent Judge Fred E. McKelvey has been designated to handle the interference. 37 CFR § 1.610(a).

Part C. Standing order

A Trial Section STANDING ORDER accompanies this NOTICE DECLARING INTERFERENCE. The STANDING ORDER applies to this interference.

Part D. Conference call to set dates

A telephone conference call to set dates for taking action in the interference is scheduled for 9:30 a.m. on 20 February 2002 (the call will be initiated from the PTO).

No later than **two business days** prior to the conference call, each party shall file and serve by facsimile a list of the preliminary motions the party intends to file. See § 17 of the STANDING ORDER.

A copy of a "sample" order setting times for taking action during the preliminary motion phase of the interference accompanies this NOTICE DECLARING INTERFERENCE.

Counsel are encouraged to discuss the order prior to the conference call with the view to coming to some mutual agreement as to dates for taking action. A typical preliminary motion period lasts approximately nine (9) months. Counsel should be prepared to justify any request for a shorter or longer period.

Part E. The parties involved in this interference are:

Junior Party

Named inventors: Alfred Pollak
Toronto, Canada

Anne Goodbody
Toronto, Canada

Patent: U.S Patent 5,662,885,
granted 2 September 1997,
based on application 08/279,155,
filed 22 July 1994

Title: Peptide derived radionuclide chelators

Assignee: Resolution Pharmaceuticals, Inc.

Accorded Benefit: None

Attorneys: See last page

Address: See last page

Junior Party

Named inventors: Alfred Pollak
Toronto, Canada

Anne Goodbody
Toronto, Canada

Patent: U.S Patent 5,780,006
granted 14 July 1998,
based on application 08/703,988,
filed 28 August 1996

Title: Peptide derived radionuclide chelators

Assignee: Resolution Pharmaceuticals, Inc.

Accorded Benefit: Application 08/279,155,
filed 22 July 1994,
now U.S. Patent 5,662,885,
granted 2 September 1997

Attorneys: See last page

Address: See last page

Senior Party

Named Inventors: William McBride
Manchester, New Hampshire

Richard T. Dean
Bedford, New Hampshire

Application: Application 08/253,973,
filed 3 June 1994

Title: Monoamine, diamide, thiol-containing
metal chelating agents

Assignee: Diatech, Inc.

Accorded Benefit: None

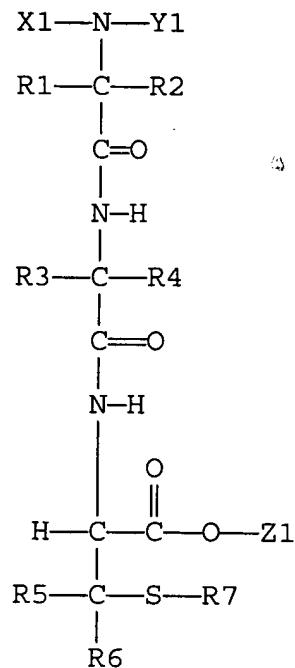
Attorneys: See last page

Address: See last page

Part F. Count and claims of the parties

Count 1

A compound having the formula:



wherein

R1 is hydrogen (-H) or C₁-C₄ alkyl;

R2 is hydrogen (-H) or C₁-C₄ alkyl;

R3 is hydrogen (-H) or C₁-C₄ alkyl;

R4 is hydrogen (-H) or C₁-C₄ alkyl;

R5 is hydrogen (-H) or C₁-C₄ alkyl;

R6 is hydrogen (-H) or C₁-C₄ alkyl;

R7 is hydrogen (-H);

X1 is C₁-C₄ alkyl;

Y1 is C₁-C₄ alkyl;

Z1 is a targeting molecule; and

alkyl is a moiety having the empirical formula

-C_nH_{2n+1}, where n is 1 to 4,

or

the compound in a form complexed with a metal radionuclide,

or

a method of detecting the localization of a targeting molecule within a mammal comprising administering a diagnostically effective amount of the compound to a mammal wherein the compound is in a form complexed with a metal radionuclide,

or

a method of imaging a site of focal inflammation within a mammal comprising administering a diagnostically effective amount of the compound to a mammal wherein the compound is in a form complexed with a metal radionuclide.

The claims of the parties are:

Pollak 5,662,885: 1-18

Pollak 5,780,006: 1-22

McBride: 2-8 and 10

The claims of the parties which correspond to Count 1, and therefore are involved in the interference (35 U.S.C. § 135(a)) are:

Pollak 5,662,885: 1-9 and 14-15

Pollak 5,780,006: 1-3, 5-6, 8-11 and 15-20

McBride: 2-3 and 10

The claims of the parties which do not correspond to Count 1, and therefore are not involved in the interference, are:

Pollak 5,662,885: 10-13 and 16-18

Pollak 5,780,006: 4, 7, 12-14 and 21-22

McBride: 4-8

The count makes a reasonable attempt to cover (1) subject matter common to that claimed by the parties, (2) subject matter claimed by Pollak that plainly would have been obvious in view of subject matter claimed by McBride, assuming the subject matter claimed by McBride is prior art to Pollak and (3) subject matter claimed by Pollak that plain or subject matter that plainly would have been obvious in view of subject claimed by Pollak, assuming the subject matter claimed by Pollak is prior art to McBride.

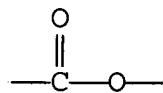
The rules authorize the filing of a preliminary motion to (1) substitute a different count, designate additional claims as corresponding to the current or a different count and (3) designate claims (currently designated as corresponding to the count) as not corresponding to the count. 37 CFR § 1.633(c).

The parties may have an opportunity to present Rule 633(c) preliminary motions after a preliminary motion period is established in the interference following the conference call scheduled for 20 February, supra. In the interim, if the parties can agree on amendments to the count and/or claims which should be designated as corresponding or as not corresponding to the count, a conference call should be placed to the judge assigned to the interference. In any event, the parties should be prepared to discuss the matter during the conference call.

The term "targeting moiety" in the count should be given its broadest reasonable construction consistent with the respective specifications of the parties. See (1) Pollak '885,

col. 4, lines 16-23, (2) Pollak '006, col. 3, lines 58-62 and
(3) McBride, page 19, lines 5-9.

The parties should observe that, as presently written, the count requires that the targeting moiety (**Z1**) be connected to the chelator through an ester group:



The term "alkyl" in the count is limited to "saturated" alkyl. Thus, the count does not include "unsaturated" alkyl groups mentioned in some of the claims in the Pollak patents. The precise definition of "unsaturated alkyl" is not apparent to the board; in any event, it does not appear that McBride describes or claims any alkyl group which might be characterized as an "unsaturated alkyl".

Part G. Heading to be used on papers

The following heading shall be used on papers filed in the interference. See § 18 of the STANDING ORDER.

Paper ¹

Filed on behalf of [name of party]

By: Name of lead counsel, Esq.

Name of backup counsel, Esq.

Street address

City, State, and Zip-Code

Tel:

Fax:

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

ALFRED POLLAK and ANNE GOODBODY,

Junior Party,
(Patent 5,662,885 and Patent 5,780,006),

v.

WILLIAM McBRIDE and RICHARD T. DEAN,

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(Application 08/253,973).

Patent Interference 104,789 (McK)

TITLE OF PAPER

Leave a blank line because the board assigns the paper number.

Part H. Summary of dates for taking action

Times for taking action are set out in the following sections of the STANDING ORDER:

1. § 7: date for identifying lead and backup counsel.
2. § 8: date for identifying any real party in interest.
3. § 9: date for requesting copies of involved and benefit applications and patents.
4. § 17: date for filing list of proposed preliminary motions.
5. § 19: date for accomplishing certain discovery.
6. § 20: date for filing clean copy of claims.
7. § 21: date for filing clean copy of claims in cases with drawings and/or claims containing a means plus function limitation.
8. § 23: dates for filing oppositions to Rule 635 miscellaneous motions and dates for filing replies to oppositions.
9. § 33: date for objecting to admissibility of evidence.
10. § 34: date for serving supplemental affidavits or evidence to respond to objection to admissibility of evidence.
11. § 35: dates when cross-examination can take place.
12. § 45: dates for taking action with respect to settlement discussions

Part I. Order form for requesting file copies

FILE COPY REQUEST

Interference 104,789 (McK)

A copy of Part E of this NOTICE DECLARING INTERFERENCE should be attached to this FILE COPY REQUEST, with a circle by hand around the patents and applications for which a copy of a file wrapper is desired.

To facilitate processing of this FILE COPY REQUEST, the following information should be included:

1. Charge fees to USPTO Deposit Account No. _____
 2. Complete address, including street, city, state, zip code and telephone number (do not list a Post Office box inasmuch as file copies are sent via commercial overnight courier).
-
-
-
-

Telephone, including area code: _____

Part J. Signature of administrative patent judge

mck

Fred E. McKelvey
Senior Administrative Patent Judge

10 January 2002
Arlington, VA

Enc:

Copy of STANDING ORDER

Copy of order used for setting times for taking action in
the preliminary motion phase of the interference (ORDERPM6)

Copy of order used for setting times for taking action in
the testimony and briefing phases of the interference
(ORDERTE6)

Copy U.S. Patents 5,443,815
5,620,675
5,662,885
5,780,006
6,017,509

Copy of McBride specification and claims.

Copy of McBride request for interference
(McBride application Paper 46, without attachments)

DECLARE.007
Revised September, 2000
(replaces DECLARE.006.1)

cc (via Federal Express) :

Attorney for Pollak
(real party in interest
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